

Application No. : 09/422,208
Filed: : October 19, 1999

thanks the Examiner for the careful review of the claims and, with respect to Claims 9, 11, 14, 16, 18, 22, and 24, the Applicant has corrected the informalities as requested.

However, the Applicant respectfully traverses the assertion of the Office Action that the term "remaining molding material" of Claims 8 lacks antecedent basis. A claim term lacks proper antecedent basis only when "it would be unclear as to what element the limitation was making reference." See M.P.E.P. § 2173.05(e). As discussed in the Applicant's first response, aspects of the presently claimed invention include an optical inspection device designed to help identify when portions of a workpiece are not cleared from a mold during removal of the workpiece. Claim 8 recites a method of, among other things, "injecting molding material ... into a mold ...; releasing the mold; and directing ultraviolet light into ... the mold ... to cause emissions from the fluorescent colorant of any remaining molding material Thus, the Applicant submits that the claim term "remaining molding material" of Claim 8 clearly makes reference to molding material left over in the mold, as required by M.P.E.P. § 2173.05(e). Accordingly, the Applicant respectfully requests withdrawal of the object to Claim 8.

REJECTION OF CLAIM 7 UNDER 35 U.S.C. § 103

The Office Action rejected Claim 7 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,632,773 (the Neefe patent) in view of U.S. Patent No. 4,236,181 (the Shibata et al. patent). In view of the above claims and the following discussion, the Applicant respectfully traverses this rejection.

Claim 7 was originally rejected as being unpatentable over Ebnesajjad et al. (the '424 patent) in view of the Shibata et al. patent. The '424 patent was distinguished by the Applicant in his initial response because it simply teaches "tagging" products with fluoroplastics for the purposes of identification and quality control, and fails to supply any teaching or suggestion for improving optical product testing or inspection devices. For example, Pages 6-7 of the Applicant's prior response stated,

Thus, the Applicant disclosed and claimed use of the emissions of the fluorescent coloring energized by ultraviolet light, not ambient light, to improve the functionality of inspection devices and to highlight potentially damaging materials leftover in the mold. For example, Claim 7 recites a method of testing a substantially transparent product with an optical tester

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where the method comprises, among other things, examining the product with an optical testing device which is responsive to the fluorescent colorant when exposed to ultraviolet light.

In contrast, the '424 patent discloses energizing products made from fluoroplastics in order to read a tag which identifies the source, lot number, or the like of the product. See Column 1, Lines 12-18, Column 2, Lines 1-5, and the like. Thus, the Applicant respectfully submits that the '424 patent does not teach or suggest improving the ability of optical product testers or optical inspection devices by using fluorescent colorant.

The Shibata patent discloses a defect detecting device where the brightness of a product measured by photodetectors is compared to a standard, which may be either the luminance of the surface mold or the plastic article under ambient light. See Column 6, Lines 18-25. Thus, the Shibata patent simply discloses a conventional inspection device which employs the luminance of the article under normal conditions to make defect determinations. Thus, the Shibata patent suffers from the same drawbacks discussed above, i.e., that some colors of material will be difficult to process. For example, when the Shibata inspection device cannot distinguish between the mold and the plastic [workpiece], the Shibata patent recommends recoloring the molding to increase the distinction between the mold and the plastic. See Column 4, Lines 18-25. The Applicant submits that the recoloring solution of Shibata still suffers from the foregoing drawbacks when the workpiece and the fluorescent colorant are transparent.

Therefore, the Applicant respectfully submits that the '424 patent and the Shibata patent, individually or in combination, do not teach or suggest the detection of defects or leftover injection molding using the visible light generated by energized fluorescent colorant. In fact, as discussed above, the Shibata patent teaches away from the claimed solution by recommending changing the color of the mold when detection becomes problematic. Accordingly, the Applicant respectfully submits that the cited prior art do not teach or suggest all of the claim elements, and therefore, the Applicant requests withdrawal of the rejection of Claim 7.

The presently relied upon prior art, the Neefe patent, teaches essentially the exact same principles. For example, similar to the '424 patent, the Neefe patent discloses tagging contact lenses with nonvisible fluorescent coloring for identification and quality control. For example, the Neefe patent discloses a doctor or practitioner shining ultraviolet light on the tagged material in a contact lens to determine various information about the contact lens. See Col. 2, Lines 35-40. Thus, the Applicant submits that just as the tagging principles of the '424 patent were not relevant to the presently claimed invention, the Neefe patent, individually, or in connection with the Shibata et al. patent, fail to teach or suggest a method of testing a substantially transparent product with an optical testing device where the optical

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testing device which is responsive to the fluorescent colorant in the workpiece when exposed to ultraviolet light. Accordingly, the Applicant maintains that the cited prior art do not teach or suggest all of the elements of Claim 7, and therefore, the Applicant requests withdrawal of the rejection of Claim 7.

REJECTION OF CLAIM 8-24 UNDER 35 U.S.C. § 103

The Office Action rejected Claim 8-24 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,656,210 (the Hill et al. patent) in view of the Neeffe patent and the Shibata et al. patent. In view of the above claims, the foregoing discussion of the Neeffe and Shibata et al. patents, and the following discussion, the Applicant respectfully traverses these rejections.

Similar to the discussion of the Neeffe patent, the Applicant respectfully asserts that the Hill et al. patent also discloses a method of manufacturing contact lenses having fluorescent identification indicia. As discussed in the foregoing with respect to the Neeffe and '424 patents, use of such identification indicia in no way teaches, suggests or renders obvious the disclosure of the claimed optical inspection device. As mentioned and asserted again by the Applicant, the Shibata et al. patent teaches away from an appropriate combination with either or both of the Hill et al. and Neeffe patent disclosures in that the Shibata et al. optical inspection system relies on ambient-visible differences between the coloring of the workpiece and the coloring of the mold. If these differences are not represented in ambient light, Shibata et al. require recoloring the molding to have visible distinctions in the same ambient light.

Accordingly, the Applicant maintains that the cited prior art do not teach or suggest all of the claim elements, and therefore, the Applicant requests withdrawal of the rejection of Claim 8-24.

It appears that the Office Action has impermissibly used hindsight derived from the teachings in the present application, and not the teachings of the prior art, to reject the pending claims. See In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness); See also, M.P.E.P., Sect. 2145, part X.A. In Dembiczak, the Federal Circuit reiterated that a determination of obviousness cannot simply rely on the inventor's disclosure as a "blueprint" without evidence of a suggestion, teaching or motivation in the prior art. Dembiczak, 175 F.3d 994,

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999. Also, according to M.P.E.P. Section 706.02(j), "[t]he teaching and suggestion to make the claimed combination and the reasonable expectation for success must both be found in the prior art and not based on the Applicant's disclosure." (emphasis added).

The Applicant therefore respectfully submits that the pending claims, Claims 7-24, are patentably distinguished over the cited references and the Applicant respectfully requests allowance of the same.

REQUEST FOR TELEPHONE INTERVIEW

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, pursuant to M.P.E.P. § 713.01, the Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner. The Applicant's attorney can be reached at (949) 721-2946 or at the number listed below.

CONCLUSION

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

John M. Grover
Registration No. 42,610
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(949) 760-0404

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Version With Markings to Show Changes Made

Insertions appear as underlined text, for example, insertions, while deletions appear as strikethrough text, for example, ~~deletions~~.

9. (Amended) The method of Claim 8, wherein the ~~flor~~escent~~fluorescent~~ colorant is substantially transparent in ambient light.

11. (Amended) The method of Claim 8, wherein the ~~flor~~escent~~fluorescent~~ colorant and the molding material are substantially transparent in ambient light.

14. (Amended) The method of Claim 8, further comprising:
directing the ultraviolet light on the workpiece; and
inspecting the workpiece based on a reaction of the workpiece to the ultraviolet light.

16. (Amended) The optical inspection system of Claim 15, wherein the ~~flor~~escent~~fluorescent~~ colorant is substantially transparent in ambient light.

18. (Amended) The optical inspection system of Claim 15, wherein the flowable materials and the ~~flor~~escent~~fluorescent~~ colorant are substantially transparent in ambient light.

22. (Amended) The optical inspection system of Claim 21, wherein the ~~flor~~escent~~fluorescent~~ colorant is substantially transparent in ambient light.

24. (Amended) The optical inspection system of Claim 21, wherein the ~~flowable materials~~ and the ~~flor~~escent~~fluorescent~~ colorant are substantially transparent in ambient light.